



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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JUL 23 2002

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 17, 30 and 49 of the morning session and questions 4, 6, 44 and 48 of the afternoon session of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 64.

On February 4, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sessions state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications

for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been granted no additional points on the Examination. No credit has been awarded for morning question 17, 30, or 49, and no credit has been awarded for afternoon question 4, 6, 44, or 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source

connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

The model answer is selection (C).

17. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect because the Japanese patent application issued after the date of Ted's application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (D) is the most correct answer because "Answer (D) can be and most likely is a 102(a) bar." Petitioner has argued that "Every foreign application is published at 18 months and thus the foreign application would have been published long before the filing date of the application with claim 2." Answer (D) refers to the foreign patent issued April 12, 2000. It is improper to assume that answer (D) instead refers to a published foreign application, and to further assume a publication date of that application. Additionally, a reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a "statutory bar." See MPEP § 715 under the heading

“SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE.” Answer (C) is the most correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 30 reads as follows:

30. Which of the following is most likely to be considered in a proper obviousness determination?

- (A) Evidence demonstrating the manner in which the invention was made.
- (B) Evidence that a combination of prior art teachings, although technically compatible, would not be made by businessmen for economic reasons.
- (C) Evidence demonstrating the level of ordinary skill in the art.
- (D) Evidence that one of ordinary skill in the art, after reading Kat’s application, would readily be able to make and use Kat’s invention without undue experimentation.
- (E) Evidence that the distance finder described in the July 2000 golf magazine has enjoyed great commercial success.

The model answer is selection (C).

30. ANSWER: The most correct answer is (C). The level of ordinary skill in the art is one of the factors that must be considered in any obviousness determination. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). (A) is not the best answer because 35 U.S.C. § 103 specifically states that patentability shall not be negated by the manner in which the invention was made. (B) is not the best answer because economic unfeasibility is not a basis for a determination of nonobviousness. See MPEP § 2145 VII. (D) is directed to the issue of enablement, not obviousness. (E) is wrong because the commercial success of the prior art distance finder is not relevant (although commercial success of Kat’s invention would be relevant).

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that his answer (D) is the most correct answer because it is applicants position that all answers be accepted. Petitioner has not provided persuasive

arguments why answer (D) is the most correct answer. Regarding answer (A), 35 U.S.C. 103 specifically states that patentability shall not be negated by the manner in which the invention was made. Regarding answer (E), the evidence does not provide any information about why the claimed invention is patentable. Answer (C) is the most correct answer. As provided in MPEP § 2141, resolving the level of ordinary skill in the pertinent art is the third of the four factual inquiries set forth by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Joe files a nonprovisional patent application containing claims 1 through 10 in the USPTO and properly receives a filing date of December 6, 2000. The first Filing Receipt including a confirmation number for the application was mailed on December 20, 2000. On January 30, 2001, the examiner mails Joe a NOTICE indicating that a nucleotide sequence listing in accordance with 37 CFR § 1.821-1.825 is required. On February 27, 2001, Joe files the required sequence listing as well as a preliminary amendment adding claims 11 through 13 to the application, along with a copy of the application as amended in compliance with the Office electronic filing system requirements. Assuming the Office has not started the publication process at such time and that Joe's application is subsequently published pursuant to 35 U.S.C. § 122(b), which of the following statements accords with proper USPTO practice and procedure?

- (A) The published application will contain claims 1 through 10 only because the preliminary amendment adding claims 11 through 13 was not submitted in reply to the NOTICE.
- (B) The published application will contain claims 1 through 13 because a copy of the application as amended in compliance with the Office electronic filing system requirements was filed.
- (C) The published application will contain claims 1 through 10 only because the copy of the application as amended in compliance with the Office electronic filing system requirements was not filed within one month of the actual filing date of the application.

- (D) The published application may contain claims 1 through 13 because the Office may use an untimely filed copy of the application as amended in compliance with the Office electronic filing system requirements where the Office has not started the publication process.
- (E) The published application will contain claims 1 through 10 only because publication is based solely on the application papers deposited on the filing date of the application.

The model answer is selection (B) and (D).

49. ANSWER: (B) and (D) are correct and (A), (C), and (E) are wrong. 37 CFR 1.215 (“(c) At applicant’s option, the patent application publication will be based upon the copy of the application...as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later. (d)...If...the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.”). The Office in a notice (“Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes”) in the Official Gazette on December 26, 2000, (1241 O.G. 97) advised that an electronic filing system (EFS) copy of an application will be used in creating the patent application publication even if it is submitted outside the period set forth in 37 CFR 1.215(c), provided that it is submitted within one month of the mailing date of the first Filing Receipt including a confirmation number for the application. While the published application is based on the application as originally filed, if applicant submits an amended version of the application via EFS within the time period set forth in section 1.215(c), the amended version of the application will be used for the publication. Based on the facts given in the question, the amended version of the application was timely filed within the fourteen-month window because the earliest filing date for which a benefit is sought is the filing date (December 6, 2000) of the application. Answers (A), (C) and (E) are all wrong because each answer states that the published application will only include claims 1-10, however, the publication will include claims 1-13 filed with the EFS submission.

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (A) is the most correct answer because model answer

(D) requires the assumption of a fact not stated. Petitioner argues that an amended application may be published ONLY if the applicant wants it to be, and that there is no evidence of that fact. 37 CFR 1.215(c) provides that the patent application publication will be based upon the amended copy, “provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements....” The fact pattern indicated that Joe filed “a copy of the application as amended in compliance with the Office electronic filing system requirements.” Accordingly, the application as amended may be published by the Office, since 37 CFR 1.215(d) indicates that if the Office has not started the publication process, “the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.” Answer (D) is the most correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 4 reads as follows:

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney’s device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?



- A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).
- B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.
- C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.
- D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.
- E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

The model answer is selection (B).

4. ANSWER: (B). Sydney is precluded from filing for a patent because of Charlie's recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has the burden to show that his chosen answer (A) is the most correct answer.

Petitioner has argued that "Answer (C), the answer selected by the PTO is incorrect."

While it is true that answer (C) is incorrect, the USPTO model answer indicates that answer (B) is correct. Petitioner's answer (A) is not correct because the witnessing of the fishhook by Charlie in June 2001 was not "by others in this country" as required by 35 U.S.C. 102(a). See MPEP § 2132.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting \_\_\_\_\_

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

The model answer is selection (A).

6. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a *prima facie* case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (A) is an incorrect answer because "it is not just the level of knowledge to practice the invention that has to be detailed, but also the level of

skill in the art.” The level of knowledge required for practice of the invention would necessarily be analyzed by the examiner in comparison to the level of knowledge held by one of ordinary skill in the art. This does not make (A) an incorrect answer. Answer (C) is a less correct answer. The affidavit in answer (C) would not be probative because it is made by someone who is not a routineer in the art, and because it recites conclusions or opinions with few facts to support or buttress the conclusions. See MPEP § 2106.02.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 44 reads as follows:

44. A condition for patentability is that an inventor is entitled to a patent unless he has abandoned the invention. Your client has engaged in conduct or omissions that may or may not be construed as abandonment of her invention. In which of the following situations would it be proper for a patent examiner to conclude, in an *ex parte* proceeding, that an inventor has abandoned the invention?

- (A) From the inventor’s inaction, following conception, to do anything over a period of time to develop or patent his or her invention, the inventor’s ridicule of another person’s attempts to develop that invention, and the inventor’s active show of interest in promoting and developing the invention only after successful marketing by another of a device embodying that invention.
- (B) When acts of another can be imputed to the inventor as an intent to abandon the invention.
- (C) From the inventor’s delay alone in filing a first patent application for the invention.
- (D) From an inventor’s delay in reapplying for patent after abandonment of a previous patent application.
- (E) From the inventor’s act of disclosing but not claiming the subject matter in a previously issued patent, even though the inventor claims the subject matter in an another patent application that is filed within one year after the patent issued.

The model answer is selection (A).

44. ANSWER: The most correct answer is (A). 35 U.S.C. § 102(c); MPEP § 2134, and see *Davis Harvester Co., Inc. v. Long Mfg. Co.*, 149 USPQ 420, 435 - 436 (E.D. N.C. 1966). (B) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991). (C) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977). (D) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Petersen v. Fee Int'l, Ltd.*, 381 F. Supp. 1071, 182 USPQ 264 (W.D. Okla. 1974). (E) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that the decision of whether there is enough evidence for an examiner to conclude there has been abandonment under 35 U.S.C. 102(c) "is for a court." Answers (A)-(E) are based on actual court decisions summarized in the MPEP. The examiner must make his or her own conclusions regarding whether or not to reject claims under 35 U.S.C. 102(c), but the court decisions and MPEP § 2134 provide guidance to the examiner. Of the five possible answers, answer (A) best describes a situation in which the courts and the MPEP indicate a rejection under 35 U.S.C. 102(c) is proper. See MPEP § 2134. Accordingly, answer (A) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme informs you that it began selling its product approximately eleven months before the

competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

48. ANSWER: (C). Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. *See, e.g.*, 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530, 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner argues that the question asks for legal advice which is beyond the purview of a

patent agent. Afternoon question 48 requires a comparison of the provisions (statutes and/or rules) relating to *ex parte* reexamination and *inter partes* reexamination. A practitioner conducting a comparison of these provisions would not be engaged in the unauthorized practice of law.

Petitioner has the burden to show that his chosen answer is the most correct answer. Petitioner selected answer (D). Petitioner argues that *inter partes* reexamination “hardly rises to the level of Acme’s desire to participate in all phases” and that “the inability of a third party requestor to appeal to the CAFC is a very grave circumstance, because the CAFC reverses so and decides the ultimate issues.” Since both (C) and (D) suggest *inter partes* reexamination, petitioner has failed to show why answer (D) is more correct than model answer (C). Answer (C) is more correct because a request for reexamination is available only on the basis of prior art patents or publications, not on the basis of prior sales activity.

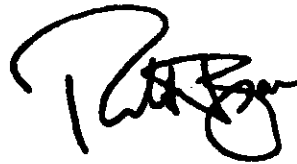
No error in grading has been shown. Petitioner’s request for credit on this question is denied.

**ORDER**

For the reasons given above, no additional points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 64. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above the printed name and title of the official.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy